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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,948

03/03/2004

Warren S. Taranow

TNW-10002/29

4130

25006

7590

12/24/2008

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EXAMINER

PATEL, TARLA R

ART UNIT

PAPER NUMBER

3772

MAIL DATE

DELIVERY MODE

12/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/791,948	Applicant(s) TARANOW, WARREN S.	
	Examiner TARLA R. PATEL	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5-9,19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5-9,19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawal of Finality

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 21 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim 21 recites the limitations that "the leg terminating in an end portion" is claiming a human body and according the rule the applicant must not claim human body.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 21 recites the limitation "the leg terminating in an end portion not covered by the band" in claim is not clear to the examiner whether applicant is claiming the leg or band, therefore the claim is not clear to the examiner. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Habermeyer et al. (5,399,152).

Habermeyer et al. discloses a continuous flexible band (20, 21 that is shown in figure 3 to be encircle around a calf portion of a human leg and thereby meets the claim limitation) “adapted to encircle a calf portion of a human leg extending entirely through the band, the leg terminating in an end portion not covered by the band” which has been treated as an intended use recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Since the limitation have not been positively claimed, it is inherent that the device of Habermeyer et al. shown is capable to be used in the manner as set forth in the functional limitations recited in the claim. The band has an inner surface (inside surface of the bladder 20, 21) spaced apart from the skin of a wearer (before evacuation of air the inner surface would be spaced apart from the skin). An outer surface (outer side of bladder 20, 21 is interpreted as outer surface) with opposing side portions (see fig 3) and a port (evacuation valve 20', 21') facilitating evacuation of the space, it is disclosed in column 3 lines 44-49 of the reference that there is, evacuation of the bladder, which has been

interpreted by the examiner to be an evacuation of the space between the inner surface of the band and the skin of the wearer so that the inner surface of the band makes intimate, slip free contact with the skin that has been interpreted by the examiner to be an evacuation of interior space which will create an intimate contact, further shown in figure 3, to inherently create slip-free contact with the skin). A rigid structure (30) is disclosed to be coupled to the side portion of the band (20, as shown in figure 3 is coupled to the side portions of the band), the rigid structure including a portion that extends around and past the end portion of the leg, thereby transferring loads to the band and calf portion as opposed to the end portion of the leg (see fig 3). However, with respect to limitations of “thereby transferring loads to the band and calf portion as opposed to the end portion of the leg during ambulation” this limitation has been treated as a functional recitation and has not been given any patentable weight. In order to be given patentable weight, a functional recitation must be expressed as a “means” for performing the specified function, as set forth in 35 USC 112, 6th paragraph, and must be supported by recitation in the claim in sufficient structure to warrant the presence of the functional language. *In re fuller*, 1929 C.D. 172; 388 C.D. 279. Further, the device of Habermeyer et al. is capable of transferring loads to the band and the calf portion.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 5 are 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark et al. (2001/0020143).

Stark et al. discloses a continuous flexible band (114) that is clearly capable of being “adapted to encircle a calf portion (see fig 1) since it is shown in Stark et al. that the band is encircling the human leg above and below knee of a human leg extending entirely through the band, the leg terminating in an end portion not covered by the band” this limitations has been treated as an intended use recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Since these limitations have not been positively claimed, it is obvious that the device of Stark et al. discloses in paragraph 0079 that the device is positioned around the intended portion of the body, therefore, the examiner interpreted that the device of Stark et al. to be used in the manner as set forth in the functional limitations recited in the claim. The band has an inner surface (inside surface of the bladder 114 is interpreted as inner surface) spaced apart from the skin of a wearer (see fig 1) that is initially spaced apart from the skin of wearer and an outer surface (outer side of bladder 114 is interpreted as outer surface) with opposing side portions (see fig 1) and a port (outlet valve 116) facilitating evacuation of the space. It is disclosed in paragraph 0066 of the reference that there is a single valve that can be used for inflation and deflation of air, which has been interpreted by the examiner as evacuation of the space between the

inner surface of the band and the skin of the wearer so that the inner surface of the band makes intimate, slip free contact with the skin this has been interpreted by the examiner to be an evacuation of interior space obviously which will create an intimate contact, to obviously create slip-free contact with the skin. A rigid structure (110) is disclosed to be coupled to the side portion of the band (114, as shown in figure 1 is coupled to the side portions of the band), the rigid structure including a portion that extends around and past the end portion of the leg, thereby transferring loads to the band and calf portion as opposed to the end portion of the leg (see fig 1). However, with respect to limitations of “thereby transferring loads to the band and calf portion as opposed to the end portion of the leg during ambulation” these limitations have been treated as a functional recitation and have not been given any patentable weight. In order to be given patentable weight, a functional recitation must be expressed as a “means” for performing the specified function, as set forth in 35 USC 112, 6th paragraph, and must be supported by recitation in the claim in sufficient structure to warrant the presence of the functional language. *In re fuller*, 1929 C.D. 172; 388 C.D. 279. Further, the device of Stark et al. is capable of transferring loads to the band and the calf portion. With respect to claim 3, Stark et al. discloses the rigid structure is permanently or temporarily attached to the side portions of the band (see figure 1). With respect to claim 5, Stark et al. discloses the fastener also can be of hook and loop type fastener [0065].

10. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark et al. in view of Hassler (6,397,400).

Stark et al. substantially disclose the invention, see rejection to claims 3, 5 are 21 above; however Stark et al. does not disclose that the device discloses an intermediate layer disposed between the inner surface of the band and the skin of the user, the intermediate layer is perforated.

However, Hassler teaches a body protection device comprising molded bodies (19, 20) accommodated in a receiving enclosure (11) that is disposed between the molded bodies and skin as shown in figures 1-2, wherein enclosure is made of natural or synthetic fibers (see column 2 lines 1-11), which can be made from a non-woven and porous textured sheet or perforated materials as broadly interpreted by the examiner that a fabric by nature is porous. At the time of the invention was made, it would have been obvious to one having ordinary skill in the art to use the enclosure of Hassler to enclose the bladder of the Stark et al., as taught by Hassler so, that the outer cover of the device would be smooth to the skin of the user.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark et al. in view of Detty (5,472,413).

Stark et al. substantially disclose the invention, see rejection to claims 3, 5 are 21 above; however Stark et al. does not disclose that brace includes a thermal-insulating layer inside the sleeve.

However Detty discloses a knee and elbow brace is made of neoprene having a thermal-insulation property (column 3 lines 30-39). At the time the invention was made, it would have been obvious to one skilled in art to make the layer of the Stark et al. device of neoprene to have thermal insulation properties, as taught by Detty to withhold the heat over the user's skin.

12. Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark et al. in view of Hydorn (2,545,146).

Stark et al. substantially disclose the invention, see rejection to claims 3, 5 are 21 above; however Stark et al. does not disclose that rigid structure include a cast, a shoe, boot, or fin.

However, Hydorn teaches an artificial limb (1, obviously it is a cast for the limb) is rigid (column 1 lines 14-17) and an upper leg section having a boot (2, column 1 lines 49-51). At the time of the invention was made, it would have been obvious to one having ordinary skill in art to use the artificial limb over the rigid structure of invention of Stark et al., as taught by Hydorn to have leg support for supporting weight of user, while the device is in use.

Response to Arguments

13. Applicant's arguments with respect to claims 3, 5-9, 19 and 21-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Habermeyer et al. (5,399,152) discloses an apparatus for treating fractures in extremities by deformable and evacuable vacuum-tight cushions having at least one valve.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TARLA R. PATEL whose telephone number is (571)272-3143. The examiner can normally be reached on M-T 6-3.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Tarla R Patel/
Examiner, Art Unit 3772

/Patricia Bianco/
Supervisory Patent Examiner, Art Unit 3772